

REMARKS/ARGUMENTS

This is a preliminary amendment in a RCE Application. The Office Action mailed January 14, 2004 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 11-16. Claims 1-10 stand "withdrawn" as directed to a non-elected group.

35 USC 112 Rejection

In numbered paragraph 2 of the Office Action mailed June 23, 2004, claims 11-16 were rejected under 35 USC 112 because there was an insufficient antecedent basis for the limitation "said annealed substrate" in line 5 of claim 11. Applicants have amended claim 11 to include the element, "providing an annealed substrate." This amendment provides an antecedent basis for the limitation "said annealed substrate."

35 USC 102(b) Rejection

In numbered paragraph 5 of the Office Action mailed June 23, 2004, claims 11 and 13-15 were rejected under 35 USC 102(e) as allegedly being anticipated the Krulevitch et al reference (U.S. Patent No. 6,437,551). Enclosed with this amendment is a DECLARATION UNDER 37 CFR §1.130 by Eddie E. Scott to "Disqualify Commonly Owned Patent as Prior Art."

The three inventors named in the subject application, Peter Krulevitch, Julie Hamilton, and Harold Ackler (The Inventors) are also inventors in the Krulevitch et al reference, U.S. Patent No. 6,437,551. The Inventors made the invention in claims 11 and 13-15 prior to the Provisional Application November 2, 1999 filing date of the Krulevitch et al reference. The Krulevitch et al reference, U.S. Patent No. 6,437,551, is assigned to The Regents of the University of

California. The subject application is also assigned to The Regents of the University of California.

A terminal disclaimer is enclosed, disclaiming the terminal portion of any patent granted on the subject application beyond the expiration date of the Krulevitch et al reference, U.S. Patent No. 6,437,551.

Applicants respectfully requests that the Krulevitch et al reference be removed as a 35 USC 102(e) reference against the subject application.

35 USC 103(a) Rejection

In numbered paragraph 7 of the Office Action mailed June 23, 2004, claims 12 and 16 were rejected under 35 USC 103(a) as allegedly being unpatentable over the Krulevitch et al reference (U.S. Patent No. 6,437,551). Enclosed with this amendment is a DECLARATION UNDER 37 CFR §1.130 by Eddie E. Scott to "Disqualify Commonly Owned Patent as Prior Art."

The three inventors named in the subject application, Peter Krulevitch, Julie Hamilton, and Harold Ackler (The Inventors) are also inventors in the Krulevitch et al reference, U.S. Patent No. 6,437,551. The Inventors made the invention in claims 12 and 16 prior to the Provisional Application November 2, 1999 filing date of the Krulevitch et al reference. The Krulevitch et al reference, U.S. Patent No. 6,437,551, is assigned to The Regents of the University of California. The subject application is also assigned to The Regents of the University of California.

A terminal disclaimer is enclosed, disclaiming the terminal portion of any patent granted on the subject application beyond the expiration date of the Krulevitch et al reference, U.S. Patent No. 6,437,551.

Applicants respectfully requests that the Krulevitch et al reference be removed as a 35 USC 103(a) reference against the subject application.

Double Patenting Rejection

In numbered paragraph 9 of the Office Action mailed June 23, 2004, claims 11-16 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 2, and 21 of the Krulevitch et al reference, U.S. Patent No. 6,437,551.

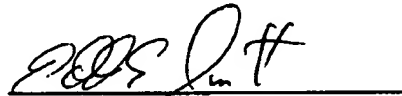
Applicants' application is assigned to "The Regents of the University of California." U.S. Patent No. 6,437,551 is also assigned to "The Regents of the University of California." The ownership of Applicants' application and U.S. Patent No. 6,437,551 is shown by the documents and by assignments recorded in the Patent and Trademark Office.

In the Office Action dated November 23, 2004 the Examiner pointed out that a timely filed terminal disclaimer in compliance with 37 CFR §321(c) may be used to overcome the rejection. A terminal disclaimer is enclosed.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated June 23, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



Eddie E. Scott
Attorney for Applicant
Registration No. 25,220
Tel. No. (925) 424-6897

Livermore, California

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